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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/679,697 | 10/05/2000 | Robert A. Hansen | 3257-39 | 8915 |

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EXAMINER

HASTINGS, KAREN M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1731 | // |

DATE MAILED: 07/08/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|--------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/679,697 | HANSEN |
| Examiner | Group Art Unit | |
| HASTINGS | 1731 | |

MF-11

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 5/02 RCE filing.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 1, 7-32 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1, 7-32 is/are rejected.

Claim(s) _____ is/are objected to.

Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - All Some* None of the CERTIFIED copies of the priority documents have been received.
 - received in Application No. (Series Code/Serial Number) _____.
 - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- | | |
|--|---|
| <input checked="" type="checkbox"/> Information Disclosure Statement(s), PTO-1449, Paper No(s). <u>8</u> | <input type="checkbox"/> Interview Summary, PTO-413 |
| <input checked="" type="checkbox"/> Notice of Reference(s) Cited, PTO-892 | <input type="checkbox"/> Notice of Informal Patent Application, PTO-152 |
| <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review, PTO-948 | <input type="checkbox"/> Other _____ |

Office Action Summary

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The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-32 are rejected under 35 U.S.C. § 112, first

paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The newly added language in claims 1 and 22 "excepting interlocking said . . . bottom layer" is new matter since it was never described in the original specification. If a negative limitation introduces a new concept into the disclosure, as here, it is new matter. See In re Anderson 176 USPQ 331, 336 (CCPA 1973) and Ex parte Grasselli, 231 USPQ 393, 394 (Bd. Pat. App. and Int. 1983). It is suggested that applicant delete this phrase. Claim 1 could be limited by reciting --said joining consisting of-- instead of "said joining including".

It is not clear that a comparable suggestion can be made for claim 22 which is drawn to the product and is not bound by how the product is made - that is, the patentability of product-by-

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process claims is determined by the product set forth and is not determined by the process limitation(s) set forth in the claims.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-32 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP 802280 or under 35 U.S.C. § 103(a) as obvious over EP 802280 as necessary with Rexfelt and/or Best.

EP '280 discloses a multi-ply paper making fabric which may be formed by a prejoined laminated offset helically wound strip.

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Each ply in said laminated offset strip structure may be different. See column 1 lines 15-41 and column 6 lines 17-35.

This reference seems to anticipate at least claims 22, 29 and 31 since these claims are product-by-process claims. It is well established that for a product-by-process claim, patentability determination is based on the product itself. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See In re Thorpe, 777 F. 2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Once the applicant has been provided with the rationale tending to show the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to the applicant to come forward establishing an unobvious difference between the claimed product and the prior art product. See In re Marosi 218 USPQ 289, 292-293 (Fed. Cir. 1983).

In the instant case, the product made by building up a spiral wound underlying offst two layer strip as shown in EP '280 appears to be indistinguishable from the final product claimed in applicant's claims. Note even if one construed claim 22+ to exclude interlocking jointing structures, in the Examiner's opinion, this still would not provide a different product and in any event to rely solely on adhesives or sewing as is well known

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in the art versus the ~~interlocking~~ of EP '280 would have been prima facie obvious to one of ordinary skill in the art.

As necessary, Rexfelt and/or Best are relied upon to teach that spirally wound layers of a felt may be of the same and/or different material to build up the press felt. Best et al. also exemplifies that additional layers of needled non-woven material and/or a "base fabric" may be used (see figures). Similarly, Rexfelt et al. exemplifies that spirally wound layers may be built up, and/or it is also possible to use a traditional tubular woven layer of base fabric to form a base fabric (see column 5 lines 19-23; also column 5 lines 24-38).

With respect to method claims 1 and 7-21, again EP '280 teaches a laminated offset spirally wound structure which is used to manufacture a paper making fabric. To eliminate the preferred ~~interlocking~~ mechanisms of EP '280, as necessary, and use the admittedly more traditional ~~interlocking~~ steps of only sewing, needling or gluing the offset portions together would have been prima facie obvious to one of ordinary skill in the art if one wanted to forgo the stated advantages of EP '280's "interlock". Note EP '280 clearly teaches that adhesive or chemically reactive systems may be used to help join the offset portions; EP '280 also teaches that the "interlock" joint is for improving the mechanical strength. Indeed on column 7 lines 10-35 it describes wherein the various plies are interconnected by the way they are

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woven and/or by tie strands, or the ribs and slots are woven into the face of each ply. It is thus not seen how the claimed joining step of stitching or sewing defines thereover. But in any event, to eliminate an "interlocking" and to use the well known joining steps of sewing, gluing, etc. would have been prima facie obvious to one of ordinary skill in the art since these are well known methods for joining fabric strips together.

Again as necessary, Best et al. and/or Rexfelt et al. are cited for teaching building up a paper making fabric with numerous layers that may be the same or different strips and/or with needled layers and/or with a base fabric.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hastings whose telephone number is (703) 308-0470. The examiner can normally be reached on Monday through Thursday from 6:30 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Steve Griffin, can be reached on (703) 308-1164. The fax phone number for this Group is (703) 305-7115.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Karen M. Hastings
Senior Primary Examiner
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7/1/02

KMH/cdc
July 2, 2002